

**REMARKS**

**Status of the Application**

Claims 1-3 and 9-10 are the claims that have been examined in the application. Claims 1-3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. (U.S. Publication 2001/0033736) (reference A of the PTO-892 part of paper no. 20070322) in view of Agnihotri et al. (U.S. Publication 2002/0081090) (reference B of the PTO-892 part of paper no. 20070322). Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. in view of Agnihotri et al. as applied to claim 9 above, in further view of Kanemitsu, U.S. Patent 6,854,127 (reference C of the PTO-892 part of paper no. 20070322).

**Claim Rejections - 35 U.S.C. § 103**

*Claims 1-3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. (U.S. Publication 2001/0033736) (reference A of the PTO-892 part of paper no. 20070322) in view of Agnihotri et al. (U.S. Publication 2002/0081090) (reference B of the PTO-892 part of paper no. 20070322).*

Claim 1 recites, in part, “extracting additional information from a digital broadcasting program and recording the additional information separately in an additional information storage unit, the additional information including title information and summary information.” The Examiner alleges that a combination of Yap and Agnihotri discloses the noted aspect of claim 1. Applicant respectfully disagrees.

In the body of the rejection, and in the Response to Arguments, the Examiner notes that “Yap teaches the presence of multiple storage units but does not explicitly state that additional

information and programs are necessarily stored together.” The Examiner then cites to *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) for the proposition that a claimed invention that differs from the prior art only in terms of its ability to separate is prima facie obvious in the absence of a new and unexpected result. However, the separation referenced in *Dulberg* can be distinguished from the instant invention. Specifically, *Dulberg* was concerned with the ability to separate a cap for a lipstick tube from the body of the lipstick tube. The actual structure of both the fixed cap lipstick tube and the removable cap lipstick tube were identical outside of the cap being removable. The Court thus held that the separability of the cap from the tube would be obvious where the prior art disclosed a fixed cap. In other words, if a structure is otherwise disclosed, the ability to separate one portion of that structure would be obvious. However, this decision would appear to be limited to actual structures. Claim 1, on the other hand, recites a *method claim* in which *additional information* regarding digital broadcasting programs is extracted from the program and stored separately from the program. However, claim 1 is not directed toward making a structural element removable, and is thus not analogous, as alleged by the Examiner. Thus, *Dulberg’s* conclusion is not applicable to claim 1.

The Examiner further alleges that “Applicant concedes that Agnihotri stores additional program information separately from the actual program ... and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” However, where neither reference discloses a particular element of a claim, attacking the references individually is permissible. In the instant application, neither Yap nor Agnihotri discloses “extracting additional information from a digital broadcasting program and recording the additional information separately,” as recited in claim 1. Yap

discloses that an electronic program guide (EPG) containing program tag information may be searched by a user, and upon selection of a program to record, tag information of previously stored programs are compared to the tag information of the selected program to determine if the program has been previously recorded. See paragraphs [0131]-[0133] of Yap. Thus, the tag information is not *extracted* from the program itself, but is provided by an outside source (the EPG). Agnihotri, on the other hand, discloses that transcripts for programs are obtained from a number of different sources of text, not extracted from the program itself. See abstract of Agnihotri. Thus, neither reference discloses “extracting additional information from a digital broadcasting program” as recited in claim 1.

Claim 1 further recites “before entering a recording mode, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit.” The Examiner alleges that Yap discloses this aspect of claim 1. Applicant respectfully disagrees.

The Examiner alleges that paragraph [0131] of Yap discloses reading additional information *before* entering a recording mode. However, paragraph [0135] of Yap indicates that a *halt recording option* is provided to a user if the duplicate episode feature identifies a match. In other words, Yap begins recording while comparing the tag information, and stops the recording when a match is identified. Thus, in Yap, the recording mode begins either before or simultaneously to tag information comparison. Similarly, Agnihotri discloses that recording a video program begins before the transcripts for the program are obtained. See FIGURE 4 of Agnihotri (elements 425 and 430). Thus, both references fail to disclose “before entering a

recording mode, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit," as recited in claim 1.

Based on the above, claim 1 is patentable over the applied art. Claim 9 recites similar limitations to claim 1, and is patentable for analogous reasons thereto. Claims 2 and 3 are patentable at least by virtue of their dependency from claim 1.

*Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. in view of Agnihotri et al. as applied to claim 9 above, in further view of Kanemitsu, U.S. Patent 6,854,127 (reference C of the PTO-892 part of paper no. 20070322).*

Claim 10 is dependent from claim 9. Because the proposed combination of Yap and Agnihotri fail to disclose all of the elements of claim 9, and because Kanemitsu fails to cure the defects noted in the proposed combination, claim 10 is patentable at least by virtue of its dependency from claim 9.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116  
Application No.: 10/653,929

Attorney Docket No.: Q75250

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: December 12, 2007